



Modified PTO/SB/33 (10-05)

## PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number

Q80281

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450 Alexandria, VA 22313-1450

Application Number

10/802,874

Filed

March 18, 2004

First Named Inventor

Hideo MATSUNAGA

Art Unit

3711

Examiner

Sebastiano Passaniti

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal

The review is requested for the reasons(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

☒ I am an attorney or agent of record.

Registration number 35,603

Signature

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February 1, 2006  
Date



**PATENT APPLICATION**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of

Docket No: Q80281

Hideo MATSUNAGA, et al.

Appln. No.: 10/802,874

Group Art Unit: 3711

Confirmation No.: 5453

Examiner: Sebastiano Passaniti

Filed: March 18, 2004

For: GOLF CLUB HEAD

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

**MAIL STOP AF - PATENTS**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Pursuant to the new Pre-Appeal Brief Conference Pilot Program, and further to the Examiner's Final Office Action dated November 1, 2005, Applicant files this Pre-Appeal Brief Request for Review. This Request is also accompanied by the filing of a Notice of Appeal.

Applicant turns now to the rejections at issue:

**I. Claim Rejections:**

Claims 1-12 are all of the claims that have been examined in the present application, and currently all of these claims stand rejected.

Claims 1-12 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Tsuchiya *et al.* (U.S. Patent No. 5,346,217; hereinafter "Tsuchiya") in view of Motomiya (U.S. Patent No. 4,438,931; hereinafter "Motomiya"), Hoshi (U.S. Patent No. 5,205,560; hereinafter "Hoshi") and Tsuchida (U.S. Patent No. 5,255,913; hereinafter "Tsuchida").

In view of the following discussions Applicant respectfully submits that the rejection of these claims is improper.

**II. Summary of Rejection:**

In rejecting the claims, the Examiner alleges that the combination of Tsuchiya, Motomiya, Hoshi and Tsuchida discloses the hollow golf club head as recited in claim 1. The Examiner relies primarily on Tsuchiya as supposedly disclosing a face portion, a sole portion, a side portion, and a crown portion as recited in the claim. The Examiner, however, concedes that Tsuchiya fails to disclose a crown portion and at least a part of the side portion having a Young's modulus lower than the face portion and the sole portion. *See* Page 3 of the Final Office Action of November 1, 2005. For these teachings, the Examiner relies on Tsuchida. *See id.* at 3.

The Examiner relies on Tsuchida to state that it would have been obvious to one skilled in the art to modify the golf club head of Tsuchiya by essentially incorporating the crown portion 5 of Tsuchida.

In view of the following discussions, Applicant respectfully disagrees.

**III. Examiner Has Not Established A Prima Facie Case Of Obviousness:**

**A. Non-Hollow Golf Club Head of Tsuchida Teaches Away From Modifying Hollow Golf Club Head of Tsuchiya With Teachings of Tsuchida.**

Applicant respectfully submits that one skilled in the art would not modify the teachings of Tsuchiya directed to a hollow golf club head with the teachings of Tsuchida, a reference which is directed to a solid core golf club head.

In properly considering what a prior art teaches or suggests to one skilled in the art, “[a] prior art reference must be considered in its entirety, i.e., as a whole, *including portions that would lead away from the claimed invention.*” M.P.E.P. § 2141.02(IV)(emphasis added).

PRE-APPEAL BRIEF REQUEST FOR REVIEW  
U.S. PATENT APPL'N NO. 10/802,874

As previously pointed out by the Applicants, Tsuchiya teaches a golf club head having a hollow construction. *See* Tsuchiya at col. 4, lines 42-47.

In contrast, Tsuchida clearly discloses a golf club head having a non-hollow core. *See* Tsuchida at col. 2, lines 28-32. Further, Tsuchida recognized two types of shell-type golf club: one having a cavity, i.e., hollow shell construction and another having a core inside a shell construction. *See* Response Under 37 C.F.R. 1.111 at page 2. In the subsequent detailed description of the preferred embodiments, Tsuchida clearly shows that its teachings are directed toward a golf club head that includes a core made of foam resin. *See id.*

Therefore, consideration of the teachings of Tsuchida in their entirety suggest the use of a non-hollow golf club head to *teaches away* from having a hollow golf club head as taught by Tsuchiya. Therefore, one skilled in the art would not modify the hollow golf club head of Tsuchiya with the teachings of Tsuchida.

B. Substantial Increase Non-Hollow Golf Club Head of Tsuchida Teaches  
Away From Modifying Hollow Golf Club Head of Tsuchiya With Teachings of Tsuchida.

One skilled in the art would also not combine the references in the manner suggested by the Examiner because the disclosure of Tsuchiya, for enlarging a sweet spot without any substantial increase in weight (col. 3, lines 44-48), *teaches away* from having a solid golf club head and the accompanying increase in weight. *See* Response Under 37 C.F.R. § 1.111 at pages 3-4.

Again, consideration of the entirety of the teachings of Tsuchiya and Tsuchida *teaches away* from modifying Tsuchiya with the teachings of Tsuchida.

C. Teachings Of Hoshi Teaches Away From a Crown Portion and At Least a Part of Side Portion Having a Young's Modulus Lower Than Face Portion and Sole Portion.

Furthermore, one skilled in the art would not combine the teachings of Hoshi with the teachings of Tsuchiya and Tsuchida because Hoshi suggests the use of a single material for the entire club head, i.e., suggests a club head having the same Young's modulus for all parts of the club head. *See* col. 2, lines 59-21.

Although the Examiner states that in Hoshi, "a distinct relationship has been acknowledged among the desired Young's modulus, the thickness of the crown, and the material chosen," Hoshi, nevertheless, suggests having a club head with a *uniform* Young's modulus, to teach away from the crown portion and the at least a part of the side portion as recited in claim 1. *See id.*

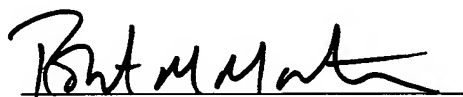
**IV. Conclusion:**

Applicant submits that the Examiner is attempting to arbitrarily combine a number of references which *teach away* from their combination as shown above. Therefore, one of ordinary skill in the art would *not* have combined the references as suggested by the Examiner.

PRE-APPEAL BRIEF REQUEST FOR REVIEW  
U.S. PATENT APPL'N NO. 10/802,874

Accordingly, Applicant hereby submits that the Examiner has failed to establish a prima facie case of obviousness, as required under 35 U.S.C. § 103(a), and hereby submits that claims 1 and 7 are patentable. Claims 2-6, which depend from claim 1, and claims 8-12, which depend from claim 7, are patentable for at least the reasons submitted for their base claims.

Respectfully submitted,



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